



1204.40319X00

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: T. UCHIDA, et al.

Application No.: 09/869,347

Filed: SEPTEMBER 7, 2001

For: MATERIALS FOR POLISHING LIQUID FOR METAL,
POLISHING LIQUID FOR METAL, METHOD FOR
PREPARATION THEREOF AND POLISHING METHOD USING
THE SAME

Group A U: 2813

Examiner: L. M. Schillinger

Confirm. No: 4090

RESPONSE

Mail Stop: AMEND
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 14, 2006

Sir:

In response to the Office Action mailed June 14, 2006, Applicants respectfully elect Specie 2 (which the Examiner refers to together with claims 164-168, 180 and 185, and which the Examiner indicates pertains "to a metal polishing liquid including an oxidizing agent, water and abrasive grains"). This election is made with traverse, as set forth in the following.

Specifically, it is respectfully submitted that the claims as listed by the Examiner in connection respectively with Specie 1 and Specie 2 are not entirely consistent with the description by the Examiner of the respective species.

Thus, the Examiner contends that Specie 1, claims 159-163, 177-179 and 181-184, pertains to a material comprising multiple solutions in a divided state into two constituent elements not mixed. However, note that claim 159 defines a metal-polishing liquid material comprising specific components (that is, an oxidized-metal etchant, a protective film-forming agent, and a dissolution promoter for the protective film-forming agent, the dissolution promoter being further defined). It is respectfully

submitted that the Examiner clearly errs where she is contending that claim 159 is directed specifically “to a material comprising multiple solutions in a divided state into two constituent elements not mixed”. In addition, claim 179, which the Examiner includes in the Specie 1 claims, is directed to a method for producing a metal-polishing liquid, including diluting the material of claim 159 with a diluent. Clearly, claim 179 does not pertain to a material as set forth by the Examiner in connection with the Specie 1 claims.

In addition, the Examiner has included claims 163 and 178 in the Specie 1 claims; however, claims 163 and 178 recite that the liquid material further comprises abrasive grains. Compare with the Examiner’s contention in connection with what constitutes the Specie 2 claims, that is, “pertaining to a metal polishing liquid including an oxidizing agent, water and abrasive grains”. Basis for the conclusion by the Examiner that, inter alia, claims 163 and 178 are within what the Examiner sets forth as Specie 1 is not seen, and this conclusion grouping, inter alia, claims 163 and 178 in Specie 1 as indicated by the Examiner is respectfully traversed.

As to claims reciting “multiple solutions in a divided state into two constituent elements not mixed”, attention is respectfully directed to claim 161 only. It is to be noted that claim 159 is generic to claim 161.

In addition, the Examiner’s attention is respectfully directed to claim 160, which the Examiner contends falls within Specie 1, and which recites that the liquid material of claim 159 further comprises “at least one of an oxidizing agent and water”. Compare with claim 164 (independent claim of Specie 2), reciting the components in claim 159, and additionally including an oxidizing agent and water. See also claim 163, dependent on claim 160, and reciting that the liquid material further comprises abrasive grains. There is not seen any basis for the conclusion by

the Examiner that, for example, claim 163, as well as claim 160, falls only within Specie 1 of "multiple solutions" as specified by the Examiner.

Moreover, the claims listed by the Examiner as Specie 2 claims, are noted. The Examiner contends that these claims 164-168, 180 and 185 pertain "to a metal polishing liquid including an oxidizing agent, water and abrasive grains". However, note that claim 164 does not recite abrasive grains; compare with claim 166, reciting that the liquid according to claim 164 further comprises abrasive grains.

In addition, the Examiner contends that 167, 168 and 180, among other claims, pertain to a metal polishing liquid including an oxidizing agent, water and abrasive grains. However, note that claims 167, 168 and 180 are directed to a method for producing a metal-polishing liquid; accordingly, basis for the conclusion by the Examiner as to the various claims falling within Specie 2 is not seen, and such conclusion is respectfully traversed.

As can be seen in the foregoing, Applicants respectfully traverse the listing of claims falling within the species, as listed by the Examiner on page 2 of the Office Action mailed June 14, 2006. If the Examiner remains of the opinion that an election-of-species requirement is proper, the Examiner is respectfully requested to re-formulate the requirement, especially with respect to allegations by the Examiner as to claims falling within the different species.

In particular, Applicants request that the Examiner reconsider and re-formulate any necessary election-of-species requirement in connection with Species 1 and 2, wherein, as seen in the foregoing, it is respectfully submitted that these Species 1 and 2, and the claims listed by the Examiner for the respective species, do not correspond in all instances.

Furthermore, it is to be noted that the method claims in the application, that is, method claims 167-174, 179 and 180, directed to a method for producing a metal-polishing liquid; and claims 175 and 176, directed to a polishing method, utilize the metal-polishing liquid material or the metal-polishing liquid of the composition claims. Applicants respectfully traverse the conclusion by the Examiner that the methods are in a Species relationship with the liquid material/liquid (composition) claims. Moreover, it is respectfully submitted that the Examiner has not established the necessary basis for restriction between the claims directed to the composition and claims directed to the method of making the composition or method of using the composition. In this regard, note Manual of Patent Examining Procedure (MPEP) 806.05(f), 806.05(h) and 806.05(i). Note especially MPEP 806.05(i) and 37 CFR 1.141(b). As the Examiner has not established a proper basis for restriction between the liquid material/liquid claims, on the one hand, and the claims directed to method of making or method of using, on this basis alone it is respectfully submitted that the requirement between the Species 1 and 2, on the one hand, and Species 3 and 4, on the other, is improper.

In any event, it is noted that claims directed to Specie 3 and Specie 4, respectively pertaining to a method of producing the metal polishing liquid and to a method of polishing, include recitation of the material of the composition claims presently in the application. Upon allowance of the composition claims, it is respectfully requested that the process claims be re-joined in the application and allowed to issue therein; see MPEP 806.05(i).

In addition, Applicants respectfully traverse the conclusion by the Examiner on page 2 of the Office Action mailed June 14, 2006, that, currently, "there is no generic [claim]" in the application, particularly insofar as applicable to Specie 1 and

Specie 2. That is, it is respectfully submitted that at least claim 159 is generic to the metal-polishing liquid material and metal-polishing liquid as in claims 159-166, 177, 178 and 181-185. Thus, note that claim 159 defines a liquid material including (a) an oxidized-metal etchant, (b) a protective film-forming agent, and (c) a dissolution promoter for the protective film-forming agent, the dissolution promoter being further defined. Claim 160, dependent on claim 159, recites that this liquid material further comprises at least one of an oxidizing agent and water (thus, within the scope of claim 160 is a liquid material including both an oxidizing agent and water); and claim 163, dependent on claim 160, recites that the liquid material further comprises abrasive grains. It is respectfully submitted that, e.g., claims 159, 160 and 163 clearly show that claim 159 is generic to a liquid material including an oxidized-metal etchant, a protective film-forming agent, a dissolution promoter for the protective film-forming agent, an oxidizing agent, water and abrasive grains; compare with the Specie 2 claims, including claims 164 and 166.

That is, note claim 164, reciting a metal-polishing liquid including components (a) through (c) discussed above in connection with claim 159, and additionally including (d) an oxidizing agent and (e) water, the dissolution promoter being defined consistent with the definition thereof in claim 159; and note also claim 166, dependent on claim 164, reciting that the liquid further includes abrasive grains. Clearly, claim 159, among other claims, is generic to the Specie 1 and Specie 2 claims; and it is respectfully submitted that the generic claims must be considered upon consideration of the Specie 2 claims in the above-identified application.

It is noted that the Examiner has indicated that the Specie 1 claims, including claim 159, are directed to a separate patentable invention from the Specie 2 claims, as seen by the contention by the Examiner on page 2 of the Office Action mailed

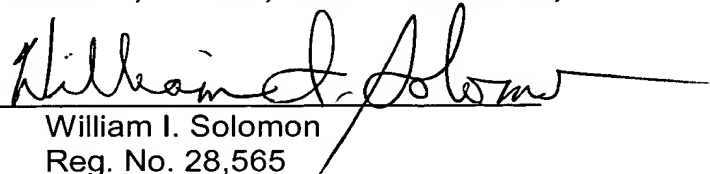
June 14, 2006, that Specie 1 and Specie 2 are directed to "patentably distinct species". Upon examination of the above-identified application on prior art, it is respectfully submitted that the Examiner must take this same position with respect to patentably distinct species.

In view of all of the foregoing, and in order to provide a complete response to the Office Action mailed June 14, 2006, Applicants respectfully elect Specie 2, which the Examiner contends pertains "to a metal polishing liquid including an oxidizing agent, water, and abrasive grains". Applicants respectfully traverse the listing of claims that the Examiner contends reads on Specie 2. To the contrary, it is respectfully submitted that claims 159-166, 177, 178 and 181-185 read on the elected Specie 2; at the very least, claims 159, 160, 162-166, 177, 178 and 181-185 read on the elected Specie 2.

Please charge any shortage in fees due in connection with the filing of this paper to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (case No. 566.40319X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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